40

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,356	10/31/2001	Satoru Matsuda	112857-299	2287

29175 7590 07/15/2005

BELL, BOYD & LLOYD, LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
REILLY, SEAN M	
ART UNIT	**PAPER NUMBER**
2153	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/001,356	MATSUDA ET AL.	
	Examiner	Art Unit	
	Sean Reilly	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's amendment and request for reconsideration filed on 4/1/2005. Claims 1-26 are presented for further examination. Independent claim 1 has been amended. Claims 2-3 were cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. With regard to claim 1, the use of the term "and/or" renders the claim indefinite. The term is interpreted to mean "or."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 8 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Podgorny et al. (U.S. Patent Number 6,078,948; hereinafter Podgorny).

2. With regard to claims 8 and 26, Podgorny disclosed an information processing apparatus for managing a plurality of communities in a virtual space, comprising:

- first storing means for storing pieces of positional information (what sessions are contained within rooms) of the respective communities in the virtual space (see inter alia Col 4, lines 43-50); and
- second storing means for storing information relating to bulletin boards (sessions) that are provided in the communities (rooms), wherein when positional information of a newly generated community is stored in the first storing means (Col 4, lines 43-50 and Col 5, lines 33-37), and
- wherein information relating to the newly generated community and which is to be written to bulletin boards of communities that are near (sessions contained within a room) the newly generated community in the virtual space is generated and stored in the second storing means and sending the generated information to the nearby communities (Col 12, line 66 – Col 13, line 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 7, 9, 11, 13, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Podgorny et al. (U.S. Patent Number 6,078,948; hereinafter Podgorny) and Salas et al. (U.S. Patent Number 6,230,185; hereinafter Salas).

4. With regard to claims 1 and 9, Podgorny disclosed an information processing apparatus for managing a community that is constructed via a network, comprising:

- a bulletin board for enabling information exchange between members of the community (sessions) (Col 4, lines 43-50); and
- information storing means for storing virtual positional information (what sessions are contained within rooms) of the community (Col 4, lines 43-50 and Col 5, lines 33-37);

Although Podgorny disclosed the invention substantially as claimed, Podgorny failed to specifically recite means for making a setting as to whether only the members of the community are to be permitted to write to or to read from the bulletin board, or whether users other than the members are to be permitted to write to or read from the bulletin board. Nevertheless such read and write restrictions within a bulletin board were well known at the time of the invention, as evidenced by Salas. In an analogous art, Salas disclosed a bulletin board system where users rights such as reading and writing to a bulletin board are restricted (Salas Col 13, line 61 – Col 14, line 11). It would have been advantageous to one of ordinary skill in the art at the time of the invention to incorporate the bulletin board system disclosed by Salas within Podgony's system, in order to protect the integrity of the bulletin board content by restricting the access rights of users (Salas Col 13, line 61 – Col 14, line 11).

5. With regard to claims 7 and 13, Salas disclosed the information processing apparatus according to claim 1, wherein information to be shown on the bulletin board includes at least one of a community ID for identification of the community, a message ID for identification of a message on the bulletin board, a time when the message was written, a user ID that is assigned to a user who wrote the message, and a message ID of another message that is included if the message is a reply to said another message (inherent; Refer to Figure 10 and Col 2, lines 52-56).

6. Regarding claim 11, Salas disclosed the first storing means further stores, for each of the communities, information of an image that has been set by an owner of the community and is to be shown on the bulletin board (Salas Col 5, lines 5-10).

7. Regarding claim 20, Salas disclosed the information processing apparatus according to claim 8, further comprising a third storing means for storing at least one of a community ID for identification of a community, a user ID that is assigned to a user who uses the virtual space, a member ID that is assigned to a member of the community for his identification, information indicating whether the member is allowed to exercise all or part of the authorities of an owner of the community, and information indicating one of a state that the user is currently a member of the community, a state that the user has withdrawn from the community, and a state that the user is not allowed to join the community again (Salas Col 13, line 55 – Col 14 line 11).

8. Regarding claims 19 and 21, the combined systems of Podgorny and Salas fail to specifically recite using email aliases to ensure user privacy. Examiner takes official notice that email aliasing was well known in the art at the time of invention. It would have been obvious to incorporate community member email aliasing within the combined Podgorny and Salas system in order to ensure a member's email address remained private from other community members.

9. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Podgorny et al. (U.S. Patent Number 6,078,948; hereinafter Podgorny) and Salas et al. (U.S. Patent Number 6,230,185; hereinafter Salas) as applied to claim 1 above, and further in view of applicant's discussion of prior art.

10. Regarding claim 3, as disclosed by applicant, it was well known in the art at the time of invention to post messages to a message board via e-mail (Applicant Specification pg 3, lines 5-6). It would have been obvious to one of ordinary skill in the art at time of invention to include an option for posting messages to a message board via e-mail in the combined Podgorny and Salas system, so users could post messages to the message board without accessing the board.

11. Applicant should note that numerous applications including well known eGroups (now Yahoo! Groups) and USENET news groups both have utilized a combination of e-mail and web interface message posting well before 2000.

12. Regarding claim 5, Salas disclosed the information processing apparatus according to claim 4, wherein the information storing means further stores information of an image that has been set by an owner of the community and is to be shown on the bulletin board (Col 5, lines 5-10).

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Podgorny et al. (U.S. Patent Number 6,078,948; hereinafter Podgorny) and Salas et al. (U.S. Patent Number 6,230,185; hereinafter Salas) and further in view of MacNaughton et al. (U.S. Patent Number 6,020,884; hereinafter MacNaughton).

14. Regarding claim 6, Podgorny and Salas failed to specifically recite a community registration and cancellation questionnaires, however registration and cancellation questionnaires for online communities were well known in the art as evidenced by MacNaughton. In a related art, MacNaughton discloses an online community system (Abstract) where users use a questionnaire to register and cancel membership (MacNaughton Col 9, lines 16-22). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the registration and cancellation procedure disclosed by MacNaughton within Podgorny and Salas's system, in order to in order to allow users to maintain multiple profiles for each community (MacNaughton Col 9, lines 18-19).

15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Podgorny et al. (U.S. Patent Number 6,078,948; hereinafter Podgorny) as applied to claim 8 above, and further in view of applicant's discussion of prior art.

16. Regarding claim 10, as disclosed by applicant, it was well known in the art at the time of invention to post messages to a message board via e-mail (Applicant Specification pg 3, lines 5-6). It would have been obvious to one of ordinary skill in the art at time of invention to include an option for posting messages to a message board via e-mail in the Podgorny system, so users could post messages to the message board without accessing the board.

17. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Podgorny et al. (U.S. Patent Number 6,078,948; hereinafter Podgorny) as applied to claim 8 above, and further in view of MacNaughton et al. (U.S. Patent Number 6,020,884; hereinafter MacNaughton).

18. Regarding claim 12, Podgorny fails to disclose a community registration and cancellation questionnaires, however registration and cancellation questionnaires for online communities were well known in the art as evidenced by MacNaughton. In a related art, MacNaughton discloses an online community system (Abstract) where users use a questionnaire to register and cancel membership (MacNaughton Col 9, lines 16-22). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the registration and cancellation procedure disclosed by MacNaughton within Podgorny's system, in order to in order to allow users to maintain multiple profiles for each community (MacNaughton Col 9, lines 18-19).

19. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Podgorny et al. (U.S. Patent Number 6,078,948; hereinafter Podgorny) as applied to claim 8 above, and further in view of Castellani et al. (U.S. Patent Number 6,742,032; hereinafter Castellani).

20. Regarding claim 23, Castellani discloses a system for monitoring and encouraging community activity (abstract). A community cricket monitors the level of activity or interaction among users (Col 4, lines 4-5) and takes a particular action when the activity drops below a certain threshold (Col 6, lines 26-29). The particular action includes sending a message that request writing to the bulletin board at a prescribed probability rate (e.g. 100%) (Col 4, lines 4-11). It would have been obvious to one of ordinary skill in the art at the time of invention to include Castellani's community cricket functionality in the online community system disclosed by Podgorny, in order to detect sleeping communities and prevent them from dying (Col 3, lines 14-19).

21. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Podgorny et al. (U.S. Patent Number 6,078,948; hereinafter Podgorny) and Salas et al. (U.S. Patent Number 6,230,185; hereinafter Salas) as applied to claim 21 above, and further in view of Olivier (U.S. Patent Number 6,480,885).

22. Regarding claim 22, the combined system of Podgorny and Salas fails to disclose a keyword based message notification system. In a related art, Olivier discloses a message based communication system (abstract) where a user "specifies a user profile and acceptance criteria for determining with whom and about what topics they wish to interact" (Col 5, lines 22-26). Olivier also discloses judging means for judging, when a new message is written to a bulletin board (Col 5, line 33), whether the new message includes the keyword (Col 5, lines 40-44); and sending means for sending an e-mail to the member who set the keyword if the judging means judges that the new message includes the keyword (Col 5, lines 44-47). It would have been obvious to combine the system of Olivier within the combined Podgorny and Salas system in order to allow users to very easily create discussion niches of meaning to them (Oliver Col 3, lines 47-48).

23. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Podgorny et al. (U.S. Patent Number 6,078,948; hereinafter Podgorny) as applied to claim 8 above, and further in view of Slashdot.org FAQ (Cited in NPL section of PTO-892; hereinafter Slashdot).

24. Regarding claims 24 and 25, Podgorny fails to disclose managing message posts based on user feedback however, such management was well known in the art at the time of invention as

evidenced by Slashdot. In a related art, Slashdot discloses a message board system where users evaluate posted messages using a point system (pg 5, How does moderation work?). The rated message score then determines whether or not the message is displayed to a user (pg 6, What are thresholds?). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the rating system disclosed by Slashdot within the system of Podgorny, in order to allow users to filter message based on user feedback (Slashdot pg 6, What are thresholds?).

25. In further considering claim 25, Slashdot discloses restricting points of evaluation to a select group of users (moderators) in order to ensure the quality of feedback (Slashdot pg 4 – Who). It would have been obvious to one of ordinary skill in the art at the time of invention to restrict points of evaluation to a select group of users, including owners of related bulletin boards, within the combined Hertz and Slashdot system in order to ensure the quality of feedback.

Allowable Subject Matter

Claims 14-18 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

3. Applicant's arguments are moot in view of the new grounds of rejection set forth.

Conclusion

26. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

27. This office action if made **NON-FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/7/05

GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100